

Remarks/Arguments

Applicant thanks the Examiner for careful consideration of the application.

Applicant has amended claims 1, 38, and 42.

No claims have been allowed by the Examiner.

I. Election/Restriction:

Examiner in Examiner's communication of 20 September 2007 drew Applicant's attention to lines 10-14 of page 3 of restriction requirements mailed on 10 October 2006. Examiner stated if "applicant were willing to admit on record that all species 1-7 are "obvious variants" then the examiner would withdraw the election of species. Applicant emphatically declines to so state. Applicant believes Examiner has failed to understand that claims to a patentably distinct species may be unpatentable based on the prior art and claims that are to patentably indistinct species may be separately patentable based on the prior art. That is patentability rests solely on what is disclosed in the prior art of record and is not based on a restriction requirement. Applicant continues to assert that Applicant's claims are patentable regardless whether they are patentably distinct and therefore they are not obvious variants.

Applicant asserts MPEP §802.01 clearly defines "distinct" in stating that related inventions are distinct "if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art)." Applicant asserts that Examiner's restriction requirement does not meet this definition because if the species are connected in at least one of design, operation, or effect then by definition the species are not distinct and, therefore, Examiner has not established a prima facie case for restricting the claims of the application. Applicant further argues that this is made clear by MPEP§806.04(f) stating "[w]here two or more species are claimed, a requirement for restriction to a single species may be proper if the species are

mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first." Applicant argues that MPEP §806.04(f) is consistent with MPEP §802.01 in that species that are not mutually exclusive will be connected in at least one of design, operation, or effect. To rephrase this, Applicant asserts species that are mutually exclusive are not connected in a least one of design, operation, or effect. Thus, Examiner must provide a reasonable explanation how Species I-VII are mutually exclusive which Examiner has not provided in this restriction requirement. Therefore, this restriction requirement is improper.

Examiner acknowledges Applicant's election with traverse of species 7. Examiner has considered Applicant's arguments but did not find them persuasive. Applicant again requests Examiner reconsider and either withdraw the restriction requirement or modify the restriction requirement. Applicant respectfully submits MPEP §808.01, requires Examiner to concisely state the particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct and specifically states a mere statement of conclusion is inadequate. In the Restriction on page 2, the rationale provided by Examiner simply makes the conclusory statement "The species are independent or distinct because they are directed to related products." No further explanation is given. Applicant asserts such a conclusory statement does not satisfy the burden and does not comply with the standards of establishing a proper restriction requirement. Since no evidence has been presented that the species are independent or distinct, a prima facie case for the propriety of the restriction requirement has not been presented.

In addition, Examiner's mere conclusory statement does not even state whether the species are independent or whether they are distinct. MPEP §808.01(a) states "[w]here there is no disclosure of a relationship between species (see MPEP §806.04(b)), they are independent inventions." MPEP §808.01(a) also states "[w]here there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction. Examiner's

mere conclusory statement provides no discussion and provides no reasons for one to conclude that the disclosed relation allows for restriction, i.e. does not prevent restriction. Since no evidence has been presented that the related products require restriction, a prima facie case for the propriety of the restriction requirement has not been presented.

Further, Applicant argues that there is clearly nothing in Figs. 8a or 8b that precludes any number of inlet channels since Species 7 is silent on the number of inlet channels. Thus claims to both one inlet channel and two inlet channels read on Species 7. Applicant can only ask why Examiner has chosen a single inlet channel rather than restrict out claims to one inlet channel and instead prosecute species 7 as only two inlet channels. Clearly Examiner's identification of species is in error since in the present Office Communication Examiner is prosecuting claims to both Species 1 and Species 7 and has not in actual fact restricted prosecution to only those claims that are related only to Species 7, assuming for the moment that Species 7 is in fact a true species; at least if Applicant understands what Examiner is trying to assert are claims related to a specific species. That Examiner's withdrawal of at least claims 2-4 and 14 is improper is, thus, clear on its face. Applicant has presented arguments to the Examiner that the heating elements shown in Figs. 8a and 8b may be utilized in any of the embodiments shown in Figs. 1-7, i.e. embodiments with one or two inlets may utilize any of the heating arrangements shown in Figs. 8a and 8b. Clearly claims to one or two inlet channels are generic to Species 7 from the standpoint that both are equally possible. Because one or two inlets are not mutually exclusive to the incorporation of a heating element Applicant continues to assert that Examiner's restriction requirement is improper.

Applicant respectfully submits the restriction requirement is also not proper because Examiner has clearly not established any undue burden for the restriction requirement in accordance with MPEP §803. As an additional reason for traversal, MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Examiner has clearly demonstrated that no undue burden exists in examining fewer species since in the first Office Action on the merits Examiner has searched and Examiner has rejected claims reading on Species 1 involving a single inlet and single feed screw having a linear pitch and has rejected claims reading on Species 2 involving a housing and a removable ceramic insert is insertable into the main cavity of the housing in addition to examining those claims reading on Species 7. Applicant can only ask why is Examiner clearly examining claims to unelected species but refusing to examine claims that read on an elected species. Clearly Species 7 is silent as to the number of inlet channels, therefore should not the Examiner under the same reasoning for refusing to examine claims to two inlets also not be examining claims to 1 inlet since Figs. 8a and 8b do not show any inlets. Thus, since Examiner is examining some claims to unelected species in the present application, no undue burden has been established if the claims to two inlets were examined as Applicant originally thought would be examined. Applicant continues to maintain Examiner's withdrawal of those claims is improper. Applicant respectfully requests Examiner modify the restriction requirement to include two inlets for the elected Species 7.

Finally, Applicant believes that Examiner does not have authority to withdraw claims elected by Applicant for prosecution under 37 C.F.R. §1.142(b). Applicant notes 37 C.F.R. §1.142(b) states "[c]laims to the invention or inventions not elected if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election," Applicant notes that 37 C.F.R. §1.142(b) refers to invention or inventions and is silent on species. Since as far as Applicant's representative is aware, in all cases where a restriction requirement is made based on two or more independent and distinct inventions, the examiner must identify the claims associated by each invention and require election by applicant whereby applicant knows which claims applicant is electing to prosecute. Only in Species restrictions does the examiner sometimes rely on applicants to identify the claims to a particular species. Applicant asserts that Examiner's withdrawal of Applicant's elected claims is improper and that Examiner should have at least either called Applicant's representative to correctly identify the claims associated with each species if Examiner believed Applicant's

elected claims were in error; or Examiner should have indicated the response to the restriction requirement was non-complaint and required election based on Examiner's identification to which claims read on which species; or Examiner should have simply provided a proper restriction requirement either correctly identifying the true species present in the instant application or identify which claims read on which species from Examiner's point of view so that Applicant could elect a particular species and be assured of which claims Applicant would be prosecuting. Applicant notes by withdrawing claims Applicant elected Applicant is now faced with prosecuting claims which Applicant would not have elected if Examiner had either properly identified the claims to the species in the original restriction requirement or had properly identified the correct species present in this application. Therefore Applicant believes this non-final Office Communication is improper and should be withdrawn since which claims are to be prosecuted has not yet been identified since there remains disagreement as to which claims are covered by Species 7.

II. Rejections under 35 U.S.C. §102 and §103:

Examiner, on page 3 of the Office Communication has rejected claims 1, 12-13, 15-17, 22-23, 34-35, 37-38, and 42 under 35 U.S.C. §102(b) as being anticipated by Cavallaro (U.S. Patent No. 6,082,289, "Cavallaro"). Examiner has also rejected claims 1, 12-13, 15-17, and 22-23 under 35 U.S.C. §102(e) as being anticipated by Fugere (U.S. Patent No. 6,983,867, "Fugere"). Examiner has also rejected claims 18-19, 20-21, 25-32, 41, 48-49, and 50 under 35 U.S.C. §103(a) as being unpatentable over Cavallaro in view of Smith et al. (U.S. Patent No. 4,090,640, "Smith"). Examiner has also rejected claim 33 under 35 U.S.C. §103(a) as being unpatentable over Cavallaro in view of Parker (U.S. Patent No. 5,890,033, "Parker"). Examiner has also rejected claims 51-52, 54-55, and 58-59 under 35 U.S.C. §103(a) as being unpatentable over Cavallaro in view of Miller (U.S. Patent No. 3,869,525, "Miller"). Examiner has also rejected claims 53 and 56-57 under 35 U.S.C. §103(a) as being unpatentable over Cavallaro in view of Miller (U.S. Patent No. 3,869,525, "Miller") and further in view of Ward (U.S. Patent No. 6,165,312, "Ward"). Applicant believes all of these rejections are rendered moot since none of the prior art references cited include all of the claim limitations found in amended independent claims 1, 38, and 42.

Applicant has again made every effort to make this Response fully responsive given the nature of the prosecution of this case. Applicant has amended claims 1, 38, and 42 in a good faith attempt to respond Examiner's refusal to enter Applicant's previous amendment as being non-responsive. Applicant asserts Examiner's arbitrary prosecution of some claims clearly reading on unelected species and withdrawal of claims clearly reading on Applicant's elected species makes Applicant's ability to amend Applicant's claims virtually impossible, since Applicant has no idea on what criteria Examiner is basing Examiner's decision to refuse to enter claims that clearly read on Applicant's elected species. Applicant continues to assert Examiner does not, under 37 C.F.R. §1.142(b), have authority to withdraw claims Applicant has elected to prosecute. Applicant continues to argue the restriction requirement is improper and at a minimum Applicant should have been afforded at least some opportunity to elect those claims which Applicant desires to prosecute before the first Office Action on the merits was undertaken by Examiner. Applicant has petitioned the restriction requirement under 37 C.F.R. §1.144. Applicant has also petitioned Examiner's refusal to enter Applicant's claim amendment mailed 25 June 2007.

HEWLETT-PACKARD COMPANY
Legal Department, IPA Section, ms: 35
P O BOX 272400
3404 East Harmony Road
Fort Collins, CO 80528-9599

PATENT APPLICATION

Attorney Docket No: 200312175-1
Application No. 10/765,628

Therefore, in view of the foregoing Amendment and Remarks, Applicant believes the present application to be in a condition suitable for allowance. Examiner is respectfully urged to withdraw the rejections, reconsider the present Application in light of the foregoing Amendment, and pass the amended Application to allowance.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Favorable action by the Examiner is solicited.

Hewlett-Packard Company
1000 NE Circle Blvd. m/s 422B
Corvallis, OR 97330
(541) 715-1694

Respectfully submitted,
Timothy D. Strecker et al.

By: /Donald J. Coulman/
Donald J. Coulman
Reg. No. 50,406
Attorney for Applicant

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